

Notice of Allowability

Application No.

10/633,832

Examiner

Constantine Hannaher

Applicant(s)

XIE ET AL.

Art Unit

2884

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to submissions of 12 December 2005.
2. ☒ The allowed claim(s) is/are 1,2 and 4-29.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

ATTACHMENT(S)

Comment on Submission(s)

1. There is no basis that applicant's representative can point to which would permit the Examiner to take claims and other legal contentions (for example, claims to foreign priority) and dismiss them as "obviously" wrong. Each one of paragraphs 1 to 6 and paragraph 8 of the action mailed August 5, 2005 was an appropriate reaction to one or more papers as filed.
2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

This application is claiming the benefit of prior-filed nonprovisional application No. PCT/JP02/04385 under 35 U.S.C. 120, 121, or 365(c). Copendency between the current application and the prior application is required. Since the applications are not copending, the benefit claim to the prior-filed nonprovisional application is improper. Applicant is required to delete the reference to the prior-filed application from the first sentence(s) of the specification, or the application data sheet, depending on where the reference was originally submitted, unless applicant can establish copendency between the applications.

MPEP § 1895.01 is not ambiguous on the subject:

Accordingly, if the international application is not subject to the filing of a demand in order to delay entry into the U.S. national phase to 30 months from the priority date¹, then a national application filed prior to the expiration of this 30 month period will be copending with the international application unless the international application was withdrawn, either generally or as to the United States, prior to the filing of the national application. To determine whether the application was withdrawn, the examiner must either review the Home Copy of the international application file (if the USPTO was the receiving Office²), or require applicant to

¹ The international application PCT/JP02/04385 is not so subject because the 20-month period from the foreign priority date did not expire before April 1, 2002.

² The receiving office was the RO/JP so this option is not relevant.

certify that the international application was not withdrawn or considered to be withdrawn, either generally or as to the United States, prior to the filing date of the national application claiming benefit under 35 U.S.C. 120 and 365(c) to such international application. In order to expedite examination, applicant should certify at the time of filing a national application claiming benefit under 35 U.S.C. 120 and 365(c) to an international application that the international application has not been withdrawn.

Applicant's representative has not made the certification plainly required under the circumstances. In deference to the discussions Applicant's representative had with supervisor Porta, the requirements of this paragraph are waived.

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

4. A reference to an international application, as made in the declaration filed December 15, 2003, is only relevant for meeting the identification requirements for a declaration filed in a U.S. national stage application filed under 35 U.S.C. 371. Accordingly, the declaration filed December 15, 2003 was not completed in accordance with the status of the application. For a declaration filed after the filing date of a nonprovisional application filed under 35 U.S.C. 111, MPEP § 602, section VI sets out the items which would be accepted as complying with the identification requirements of 37 CFR 1.63. Since the application number and the attorney docket number appear on the face of the declaration filed December 15, 2003, upon reconsideration it is agreed that the declaration identifies the specification notwithstanding the irregular location of the identifying items.

5. The drawings were received on December 12, 2005. These drawings are acceptable.

6. Applicant's arguments, see pages 15 and 16, filed December 12, 2005, with respect to claims 1 and 2 have been fully considered and are persuasive. The rejection of claims 1 and 2 and those claims dependent thereon in view of *Ozawa et al.* and *Abe et al.* has been withdrawn.

7. The Examiner notes that page 40 of the specification is unhelpful in providing antecedent basis and support under 35 U.S.C. 112, first paragraph for the amendments made to claims 1 and 2. However, page 43 is sufficient for references to focal position and focal range, and page 44 is sufficient to references to numerical aperture (NA).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Constantine Hannaher whose telephone number is (571) 272-2437. The examiner can normally be reached on Monday-Friday with flexible hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Porta can be reached on (571) 272-2444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Constantine Hannaher
Primary Examiner